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U.S. Serial No. 09/891,920

Group Art Unit: 3692

Attorney Docket No. 8716.00

Examiner: Sarah M. Monfeldt

Attached herewith are the following items for the above-identified patent application:

- (1) an Appeal Brief in furtherance to the Notice of Appeal of August 29, 2008 (8 sheets); and
- (2) if applicable, a Request for Extension of Time (0 sheets).

Respectfully submitted,

Michael Chan

Reg. No. 33,663

CERTIFICATE OF TRANSMISSION

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Dayton, Ohio

Docket No. 8716.00

Application of

OCT 29 2008

Kenneth A. Nicoll et al.

Serial No. 09/891,920

Group Art Unit: 3692

Filed: June 26, 2001

Examiner: Sarah M. Monfeldt

For: **SELF-SERVICE TERMINAL**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on August 29, 2008. Authorization is given to charge deposit account number 14-0225 for the fee under 37 C.F.R. 1.17 for filing the Appeal Brief.

(1) REAL PARTY IN INTEREST

The present application is assigned to NCR Corporation of Maryland.

(2) RELATED APPEALS AND INTERFERENCES

None.

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(3) STATUS OF CLAIMS

The above-identified patent application was filed on June 26, 2001 with claims 1-14. In response to an Office Action mailed April 25, 2006, no claims were canceled or added. In response to an Office Action mailed October 2, 2006, no claims were canceled or added. In response to an Office Action mailed May 4, 2007, no claims were canceled or added. In response to an Office Action mailed October 12, 2007, no claims were canceled or added. In response to an Office Action mailed November 28, 2007, no claims were canceled or added. In response to an Office Action mailed June 5, 2008, claims 11-14 were canceled. In response to an Advisory Action mailed on August 1, 2008, a Notice of Appeal was filed on August 29, 2008. Thus, claims 1-10 remain pending and stand rejected.

Claim 1 is being appealed and is attached as an appendix to this Appeal Brief.

(4) STATUS OF AMENDMENTS

No amendments were entered subsequent to the last final rejection which was mailed on June 5, 2008.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1

A self-service terminal 10 (page 5, lines 2-3) comprising:
a plurality of separate media modules 20, 22 (page 5, lines 11-12; line 26), each media module being operatively associated with a separate pick mechanism for picking media from the media module and transferring the picked media to a media dispense path (page 5, lines 13-16; page 5, line 28 to page 6, line 2), at least a first one of the media modules 20 being associated with a separate vacuum pick mechanism 30 (page 5, lines 13-16), and at least a second one of the media modules 22 being associated with a separate friction pick mechanism 48 (page 5, line 28 to page 6, line 2).

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(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

An issue presented for review is whether claim 1 is patentable under 35 U.S.C. Section 103(a) over U.S. Patent No. 6,484,380 to Graef et al. in view of U.S. Patent No. 6,029,971 to Lynch et al., and further in view of U.S. Patent No. 3,961,784 to Sevak et al.

(7) ARGUMENT

Applicant would like to point out that the rejection of claim 1 of the present application is improper for at least the following reasons.

First, Applicant would like to point out that Graef et al. ("Graef") does not disclose a self-service terminal which comprises both a vacuum pick mechanism which is associated with one of a plurality of separate media modules and a separate friction pick mechanism which is associated with another one of the plurality of separate media modules. Applicant notes that the Office refers to column 13, line 64 to column 14, line 7 of Graef, and concludes that Graef teaches two different types of picking mechanisms within one unit. In this regard however, Applicant submits that the friction pick mechanism of Graef is intended be retrofitted into a unit which has an existing friction pick mechanism, and not into a unit which has an existing vacuum pick mechanism, as the Office would like to suggest. Applicant submits that the friction pick mechanism of Graef cannot be retrofitted into a unit which has an existing vacuum pick mechanism because the entire unit would need to be overhauled and rewired to be able to accommodate any friction pick mechanism, let alone the friction pick mechanism of Graef. Such overhauling and rewiring of the unit to accommodate a friction pick mechanism is not only impractical, but also well outside of the scope of what Graef actually teaches with respect to "retrofitting". Accordingly, Graef does not disclose two different types of picking mechanisms (i.e., a vacuum pick mechanism and a friction pick mechanism) within one unit, as the Office would like to suggest. If the Office persists in arguing that the friction pick mechanism of can be retrofitted into a vacuum pick mechanism, then Applicant requests that the Office provide a full explanation of how this would be accomplished by a person of ordinary skill in the art.

Second, Applicant would like to point out that Lynch et al. ("Lynch") also does not

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disclose a self-service terminal which comprises both a vacuum pick mechanism which is associated with one of a plurality of separate media modules and a separate friction pick mechanism which is associated with another one of the plurality of separate media modules. In this regard, Applicant would like to point out that Lynch teaches that known automated teller machines will have either a vacuum pick type of mechanism or a friction pick type of mechanism, but not both types of mechanisms. This is no more than what Applicant has admitted in the background section of the present application. In fact, Applicant is not aware of any self-service terminal which comprises both a vacuum pick mechanism which is associated with one of a plurality of separate media modules and a separate friction pick mechanism which is associated with another one of the plurality of separate media modules.

Third, Applicant would like to point out that Sevak et al. ("Sevak") does not cure any deficiencies of Graef and Lynch. In this regard, Applicant would like to point out that Sevak discloses a friction pick mechanism with a vacuum assist. A friction pick mechanism with a vacuum assist (as disclosed in Sevak) is not the same as a vacuum pick mechanism which is associated with one of a plurality of separate media modules and a separate friction pick mechanism which is associated with another one of the plurality of separate media modules (as claimed in the present application).

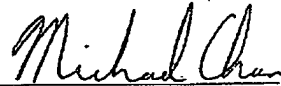
In summary, none of the cited references, alone or in combination, discloses both a vacuum pick mechanism which is associated with one of a plurality of separate media modules and a separate friction pick mechanism which is associated with another one of the plurality of separate media modules.

Conclusion

In view of the forgoing reasons, it is clear that the rejection of claim 1 under 35 U.S.C. Section 103 (a) is improper and, therefore, should be withdrawn. It is respectfully requested that the Board reverse the rejection of claim 1.

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Respectfully submitted,



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(8) CLAIMS APPENDIX

1. A self-service terminal comprising:

a plurality of separate media modules, each media module being operatively associated with a separate pick mechanism for picking media from the media module and transferring the picked media to a media dispense path, at least a first one of the media modules being associated with a separate vacuum pick mechanism, and at least a second one of the media modules being associated with a separate friction pick mechanism.

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(9) EVIDENCE APPENDIX

None.

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(10) RELATED PROCEEDINGS APPENDIX

None.